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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

*EX PARTE GHASSAN CHIDAC, SANJAY GUPTA, JEFF NORDYKE,
GIANCARLO PALLESCHI, MATTHEW ROSENTHAL, and
ARNOLD O. VIMBA*

Appeal 2008-5219
Application 09/730,219
Technology Center 2100

Oral Hearing Held: February 11, 2009

Before JOHN C. MARTIN, JEAN R. HOMERE, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANTS:

LAWRENCE HARBIN, ESQUIRE
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1 The above-entitled matter came on for oral hearing on Wednesday,
2 February 11, 2009, at The U.S. Patent and Trademark Office, 600 Dulany
3 Street, Alexandria, Virginia, before Lorie B. Allen, Notary Public.

4

5 JUDGE MARTIN: Good morning. You may start when you're ready.
6 Please proceed.

7 MR. HARBIN: First, I want to thank the Board for allowing us the
8 opportunity to present our side of the case.

9 I have just a couple of exhibits which are parts of the record that I
10 want to focus on. If you don't mind, maybe we can share a copy.

11 JUDGE MARTIN: Yes, if you can figure out how to do that.

12 MR. HARBIN: This matter involves, I think, more of a procedural
13 question than a question of merit, whether the prior art shows the particular
14 feature of the invention, but it may help as some background to understand
15 what the technology is.

16 The invention concerns converting Legacy data files or old data files
17 into a current format that's useable, such as XML or HML web pages and
18 what not.

19 The problem that many companies have is they have a lot of old
20 Legacy files. The question is how do you convert these files to a current
21 data format.

22 What the invention does is look at the old Legacy files, consider what
23 the requested format is by the user, and then figure out which format of the
24 old Legacy files would be best suited to do a translation, and that

1 determination could be made based on the amount of processing time or it
2 could be made on the basis of the amount of data loss.

3 The critical element in claim one, which is commonly called the
4 independent claims, is determining an optimal file format from a plurality of
5 some Legacy data files for use in performing the translation to a requested
6 format.

7 Now, the prior art that the Examiner cited, and he used a 103 rejection
8 to reject claim one and the other independent claims, the prior art addresses
9 the problem by converting the Legacy files to a common format and then
10 using the common format to convert to a standard current data format.

11 What the invention does is say okay, these Legacy files exist in
12 several formats. I'm going to pick the best one and that's the one I'm going
13 to use to do my translation.

14 Well, the Examiner rejected claim one and the other claims in the case
15 based on what he called this prior art reference, Ogawa, and admitted prior
16 art.

17 What we take issue with here in this case is what is and what is not
18 admitted prior art. The Examiner used a particular statement in the
19 background of the invention and he combined it with the cited art, and he
20 says the invention was obvious.

21 Just to point out again what the Examiner says, and it is contained
22 throughout the prosecution history and again in his brief, the Examiner's
23 Answer, rather, he says Ogawa, the prior art, does not explicitly teach the
24 optimal file format, but the admitted prior art discloses the claimed optimal

1 file format from which the plurality of file formats could be used to do this
2 translation.

3 It would help to see what in fact the Examiner relies on in terms of
4 what is in the specification. Page three of the specification -- I hope you can
5 see this from here -- says that -- this is in the background section of the
6 Application.

7 The Examiner relies on one paragraph on page three where the
8 Applicant says "Since it may often be the case that a requested file exists
9 within an enterprise in many different formats other than the requested
10 format, a further advantageous aspect of the transcoding scheme would
11 provide logic for selecting the optimal version of a requested data file from
12 which to perform the translation."

13 Now, the question is is this statement in the background a
14 characterization of the prior art or is it a characterization of what's being
15 claimed in this Application.

16 The Examiner contends this statement characterizes the prior art and
17 he is using it in conjunction with the primary reference to construct his
18 argument.

19 If you look carefully at this paragraph on which the Examiner relies,
20 he is focusing on this transcoding scheme that purportedly is in the prior art.
21 The transcoding scheme is in the prior paragraph, and the Examiner did not
22 refer to the prior paragraph, but instead, we believe, took it out of context.

23 The prior paragraph said purportedly "It can be seen that there is a
24 need to provide a seamless data format translation or transcoding scheme to
25 further improve" the enterprise.

1 It is our position that this is the invention. The Examiner's position
2 that well, if you have that in the background, then that's admitted prior art.
3 What he is saying is if we move this paragraph to the summary or to the
4 detailed description of the invention, then it would not be admitted prior art.

5 The Examiner refers to certain sections of the MPEP which states
6 what should be in the background of the invention and what should be in the
7 summary and other parts of the Application.

8 We're saying the form of the matter should not exhaust the substance
9 of it. I can say to myself I inherited this case, but nevertheless, it's our
10 position that the Examiner's argument is displaced as to what this paragraph
11 means and whether or not it is admitted prior art.

12 That's the crux of this case.

13 The Examiner goes on to reject some of the other independent claims
14 --

15 JUDGE MARTIN: Excuse me, counsel, before you leave this point.
16 Would it be fair for the Examiner to rely on just the first two sentences of
17 that paragraph as admitted prior art, the fact that there may be
18 -- I'm sorry, up to the comma in the second line there -- is that an admission
19 that requested data files exist in different formats?

20 MR. HARBIN: That's admitted.

21 JUDGE MARTIN: That's okay?

22 MR. HARBIN: Sure. No problem whatsoever.

23 JUDGE MARTIN: The Examiner didn't want to just use that, he
24 wanted to use the rest of it.

1 MR. HARBIN: Correct. That's right. Our point again is that
2 second phrase of that sentence characterizes a need or a wish list or a desire,
3 and not prior art.

4 JUDGE HOMERE: A question for you here. That portion here says
5 "A further advantageous aspect of the transcoding scheme would provide
6 logic for selecting the optimal version."

7 MR. HARBIN: Yes; right.

8 JUDGE HOMERE: How do you know that?

9 MR. HARBIN: The transcoding scheme could be in software or
10 hardware. It's not a question of whether it can be done by logic.

11 JUDGE HOMERE: How do you know it would provide such
12 benefits?

13 MR. HARBIN: I understand your point. One could read it that way,
14 but the prior sentence makes it a need. It's a need to provide this
15 transcoding scheme. Read together, it's characterizing a desire and not prior
16 art.

17 Again, my point is if this section was in the detailed description, it
18 shouldn't make any difference in terms of the ultimate outcome of the case.
19 It shouldn't, but because it was in the background, the Examiner described it
20 as being prior art. We take issue with that.

21 JUDGE HOMERE: I don't agree that that same phrase or sentence in
22 the description could not -- it depends on exactly what it is saying. If it
23 purports to all information, regardless of where it is, the Examiner could
24 reasonably rely on it as prior art, admitted prior art.

1 MR. HARBIN: If the Examiner had not focused on that section of the
2 MPEP press, I would have redirected my focus. The Examiner relied
3 heavily on what should be in the background and what should be in the
4 detailed description. We are attacking his rejection on that basis.

5 Claims one and two, for example, he uses the same paragraph to
6 reject, and we say in this determining step, it is further limiting in claim one
7 and two by determining it according to data loss, three says determining
8 according to processing overhead.

9 The Examiner is reading the same paragraph to reject claims two and
10 three.

11 JUDGE HOMERE: Notwithstanding what the Examiner said, is the
12 transcoding scheme known in the art for selecting an optimal version of the
13 requested data file?

14 MR. HARBIN: The transcoding scheme is known for selecting a data
15 file -- for converting a data file. There is no known transcoding scheme for
16 selecting an optimal format from which to begin the translation.

17 JUDGE HOMERE: Let's be clear here. Are transcoding schemes
18 known for selecting a version?

19 MR. HARBIN: Yes.

20 JUDGE HOMERE: Of a data file.

21 MR. HARBIN: Right.

22 JUDGE HOMERE: To perform a translation.

23 MR. HARBIN: Correct.

24 JUDGE HOMERE: The improvement here is optimal?

25 MR. HARBIN: That's right. I'm sorry. That is the point.

1 JUDGE MARTIN: Is the improvement the selection of the optimal
2 version or having logic that does it? What happened in the past when there
3 were referral versions of the same file?

4 MR. HARBIN: Well, in the past, there was no mechanism, no
5 process in place to figure out which one should be used. They just
6 arbitrarily picked one.

7 JUDGE MARTIN: It was a human selection?

8 MR. HARBIN: Right, a human selection. They always picked the
9 text file to do the translation. In the past, there was no mechanism in place
10 for picking a particular optimal best file from which to start the translation.

11 JUDGE MARTIN: They wouldn't say you look at the one that has
12 the most recent date and assume that's the best one?

13 MR. HARBIN: Right. Manually, a mental determination by a
14 human.

15 It may be important to look at some parts of the specification, just two
16 locations, that came to my attention as I re-read it, to project that the
17 invention is in fact finding this optimal data file from which to start the
18 translation.

19 If you look at page six, the fourth full paragraph, it says "A further
20 inventive feature provided herein addresses the determination of the
21 appropriate stored file format to be used to perform a translation," and it
22 goes on.

23 Then it says "The determination of which stored format is to be used
24 is preferably based on such considerations as minimizing data loss or

1 processing overhead as well as the nature of the requested file format and the
2 availability of stored file format.”

3 In the summary of the invention, there is the further characterization
4 of where the invention is focused.

5 On page 15 in the first paragraph, about four lines down, it says “This
6 data format preference, 220,” which refers to the optimal format, “will be
7 relevant in permitting the enterprise to assess whether or not the requested
8 record is available in a preferred format and if not, whether the translation to
9 the preferred format may be undertaken, and if so, which stored format for
10 the record should be used to best accomplish the translation.”

11 The invention is clearly focused on this optimal or the best one to do
12 so. The Examiner admitted even in his rejection, well, Ogawa doesn’t show
13 -- the prior art doesn’t show the optimal format, but the Applicant admits it
14 in its background of invention.

15 We say he took it out of context because that section of the
16 specification read together characterizing this transcoding scheme as being a
17 need to be accomplished, and then in the second paragraph, on which he
18 relies, that second phrase of that paragraph is characterizing a wish list or
19 need, not the prior art.

20 That’s our point. With respect to some of the technical arguments on
21 merit, there are a few other claims that were rejected on merit, and we rely
22 on the brief.

23 This is the primary one. If this is resolved, the whole matter is
24 resolved.

25 JUDGE MARTIN: All right. Any further questions?

1 (No response.)

2 JUDGE MARTIN: Thank you, counsel. We'll take the case under
3 advisement.

4 MR. HARBIN: Thank you.

5 (Whereupon, the proceedings were concluded on February 11, 2009.)